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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,915	08/31/2001	Andreas Westendorf	10191/2007	3903
7590 KENYON & KENYON One Broadway New York, NY 10004		02/11/2008	EXAMINER PYZOSHA, MICHAEL J	
			ART UNIT 2137	PAPER NUMBER
			MAIL DATE 02/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/944,915

Applicant(s)

WESTENDORF ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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#### **DETAILED ACTION**

1. Claims 22-47 are pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/2007 has been entered.

#### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: nowhere in the specification is it described that the check result not used to process the first data.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 47 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe that the check result is not used to process the first data nor does it disclose that it is used to process the first data. However, the mere absence of a positive recitation is not basis for exclusion. See MPEP 2173.05(i).

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 22-24, 26-28, 31-34, 36, and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. (US 7051005) in view of Serkowski (US 6513121).

As per claims 22, 23, 41-45, and 47 Peinado et al. discloses transmitting first data to a first processor from one

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of a data medium drive and a third processor (see column 2 lines 41-56); transmitting second data to a second processor, the second data being based on the first data; checking the second data in the second processor to determine if the first data may be processed in the first processor (see column 3 lines 10-43); transmitting a positive check result to the first processor (see column 3 lines 31-43); and responsive to receiving the positive check result, processing the first data at the first processor (see column 3 lines 44-54).

Peinado et al. discloses sending a positive check result as described above, but fails to explicitly disclose sending a check result additionally when it is negative.

However, Serkowski teaches sending a check result when it is negative (see column 2 lines 3-30).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send both positive and negative check results in the Peinado et al. system.

Motivation as recognized by one of ordinary skill in the art to do so would have been to notify the requestor that the request has been denied.

As per claim 24, the modified Peinado et al. and Serkowski system discloses the limitations substantially similar to those of claim 22 and further discloses, wherein the step of

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transmitting the first data include transmitting the first data to the first processor from a data medium drive, and wherein the method further comprises: checking in the second processor an identity of a data carrier in the data medium drive (see Peinado et al. column 3 lines 31-43).

As per claim 26, the modified Peinado et al. and Serkowski system discloses checking an error-free transmission in at least one of the first processor and the second processor (see Peinado et al. column 2 line 66 through column 3 line 5).

As per claims 27 and 28, the modified Peinado et al. and Serkowski system discloses the data is transmitted in encoded form (see Peinado et al. column 2 line 66 through column 3 line 5).

As per claims 31, 33-34 and 36, the modified Peinado et al. and Serkowski system discloses accessing a database and allowing and storing data (see Peinado et al. column 3 lines 31-43).

As per claim 32, the modified Peinado et al. and Serkowski system discloses, initiating by the second processor a payment process as a function of the second data (see Peinado et al. column 20 lines 51-60).

As per claims 39 and 40, the modified Peinado et al. and Serkowski system discloses determining a first check code is determined from the first data; and forming the second data at

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least in part from the first check code (see Peinado et al. column 2 line 66 through column 3 line 43).

As per claim 47, the modified Peinado et al. and Serkowski system discloses the check result is not used to process the first data (see Peinado et al. column 19 lines 12-27 and Serkowski column 2 lines 3-30).

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Peinado et al. and Serkowski system as applied to claim 22 above, in view of Okada (US 6704872).

As per claim 25, the modified Peinado et al. and Serkowski system discloses transmitting the first data to the first processor from a third processor (see column 2 lines 45-60 and figure 1), but fails to disclose including an identity of the processor with the authentication information.

However, Okada teaches including such information (see Abstract).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to including the identity of the processor with the information of the modified Peinado et al. and Serkowski system.

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Motivation to do so would have been to restrict the use of a specific software program to a single processor (see Okada abstract).

9. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Peinado et al. and Serkowski system.

As per claims 29 and 30, the modified Peinado et al. and Serkowski system fails to disclose the use of wireless connections.

However, Official Notice is taken that at the time of the invention it would have been obvious to one of ordinary skill in the art to use wireless connections.

Motivation to do so would have been to allow for mobility.

10. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Peinado et al. and Serkowski system as applied to claim 22 above, in view of Gurr (US 4264960).

As per claim 35, Peinado et al. fails to disclose starting a check of the first data in the first processor; and restarting the check in the first processor if the check has not been run through completely.

However, Gurr et al teaches such a check (see column 16 line 52 through column 17 line 3).



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At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the checking system of Gurr in the modified Peinado et al. and Serkowski system.

Motivation to do so would have been to check a message for errors (see Gurr column 16 line 52 through column 17 line 3).

11. Claims 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Peinado et al. and Serkowski system as applied to claim 22 above, in view of Coley et al. (US 5790664).

As per claim 37, the modified Peinado et al. and Serkowski system fails to disclose deleting data if there is no license.

However, Coley et al. teaches such a practice (see column 14 lines 57-67).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to delete the content of the modified Peinado et al. and Serkowski system if there is no license.

Motivation to do so would have been to protect the data from unauthorized use (see Coley et al. column 14 lines 57-67).

As per claim 46, the modified Peinado et al., Serkowski and Coley et al. system discloses the checking is executed at

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specifiable time intervals (see column 8 lines 54-69 and column 9 lines 1-22 and 42-51).

12. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Peinado et al. and Serkowski system as applied to claim 22 above, in view of Flick (US 6140939).

As per claim 38, the modified Peinado et al. and Serkowski system fails to disclose delivering a warning if the first data is not released.

However, Flick teaches such a warning (see column 3 lines 7-23).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the warning of Flick in the system of the modified Peinado et al. and Serkowski system.

Motivation to do so would have been to allow for updating of samples (see column 3 lines 7-23).

### ***Response to Arguments***

13. Applicant's arguments filed 12/17/2007 have been fully considered but they are not persuasive. Applicant argues that the rejection of claim 47 under the first paragraph of 35 USC

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112 is improper and Peinado fails to disclose sending a check result (both positive and negative).

With respect to Applicant's argument that the rejection of claim 47 under the first paragraph of 35 USC 112 is improper, the specification provides no description as to whether the check result is used or not used in the processing of data. As described in section 2173.05(i) of the MPEP, the mere absence of a positive recitation is not basis for exclusion. In other words, when the specification does not positively recite an act (i.e. the use of the check result in the processing of data) one cannot exclude this act in the claims. One of ordinary skill in the art would read the specification and see that there is neither a description of the use of the check data in the processing nor a description excluding the use of the check data in the processing. Therefore, this lack of positive recitation is not a basis for exclusion and must be rejected under the first paragraph of 35 USC 112 for failing to comply with the written description requirement.

Applicant's Argument's with respect to Peinado are moot in view of the new grounds of rejection put forth above.

**Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

NASSER MOAZZAMI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
2/8/08